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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,294	12/03/2001	John A. Ragan	PC10847A	2695

23913 7590 07/08/2003

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[REDACTED] EXAMINER

FAN, JANE T

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1625

DATE MAILED: 07/08/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/008,294	RAGAN, JOHN A.
	Examiner Jane T. Fan	Art Unit 1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-13 is/are pending in the application.
  - 4a) Of the above claim(s) 12 and 13 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-11 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

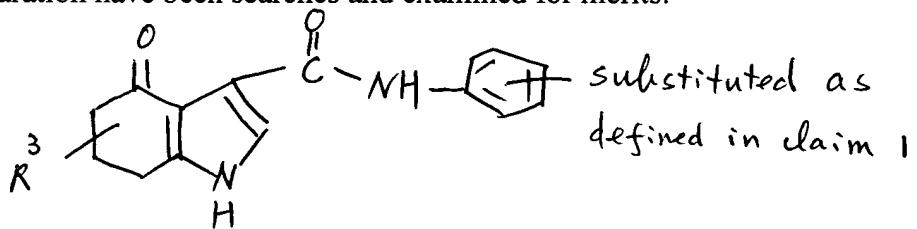
1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> .	6) <input type="checkbox"/> Other: _____.

### DETAILED ACTION

1. Applicant's election with traverse of group I, a single disclosed species of compound on page 8, lines 1-2 in Paper No. 7 is acknowledged. The traversal is on the ground(s) that there is no undue burden since the search is in class 544 only. This is not found persuasive because there are classes 546, 548 to be searched. 546, 544 are classes not subclasses. It is further noted that compounds of formula I lack a common nucleus in view of variable n.

The requirement is still deemed proper and is therefore made FINAL.

In view of applicant's election, the subject matter of claims 1-11, the compounds of the following structure, their preparation have been searched and examined for merits:



Claims 12-13 and the remaining subject matter in claims 1-11 have been withdrawn from consideration. 37CFR1.142(b).

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 98/02420, WO97/34870, patent 5,484,944. Note examples 1, 5 for process , page 51 for compounds and also note the print out enclosed for WO 98/02420. For WO97/34870, note pages 32, 35. For pat'944, note the print out.

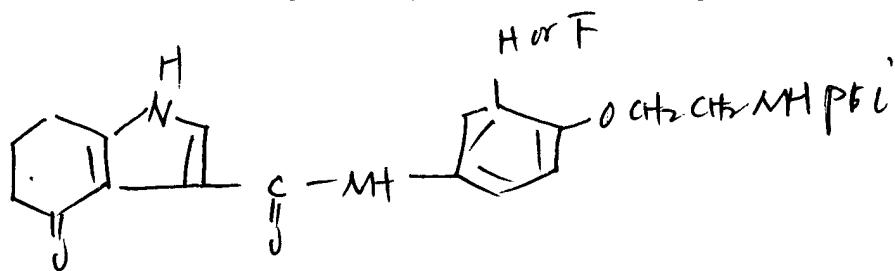
a. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over patent 6,080,873.

In establishing a case of *prima facie* obvious, the following is noted:

(a) MPEP2141.01. The Albaugh et al. The reference specifically teaches the following compounds:



(b). MPEP 2141.02. The difference between the claimed compounds and the compounds in patent '873 by Albaugh et al. is the linking group of the substituent on the phenyl group, -OCH<sub>2</sub> of the reference versus -OCH(CH<sub>3</sub>) of the claims.

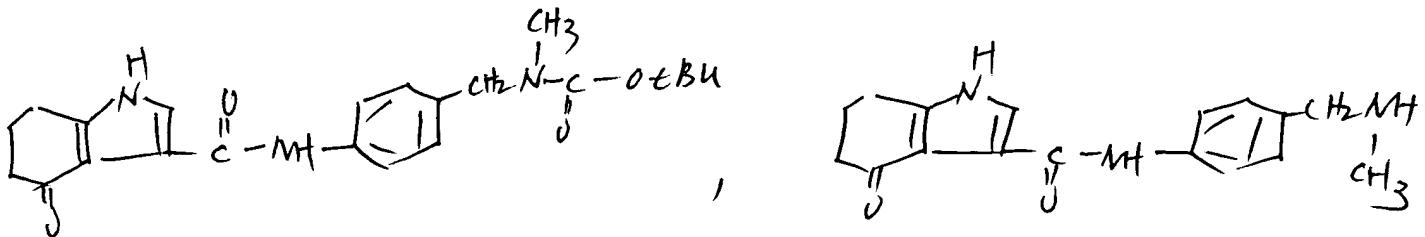
(c). MPEP 2143.01-02. It would have been obvious to one skilled in the art to use a homolog, methyl instead of H in pat' 873 to come up to the claimed compounds since adjacent homologs are suggested for the same uses. One having ordinary skilled in the art would have been motivated to use an adjacent homolog of a known compound for the same uses with a reasonable expectation of success.

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5. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over patent 6,262,272(same as WO 99/25684), WO97/26243.

In establishing a case of *prima facie* obvious, the following is noted:

(a) MPEP2141.01. The reference specifically teaches the following compounds:



(b). MPEP 2141.02. The difference between the claimed compounds and the compounds in the art is the linking group of the substituent on the phenyl group , -CH2NCH3 of the reference versus -CH(CH3)NCH3 of the claims.

(c). MPEP 2143.01-02. It would have been obvious to one skilled in the art to use a homolog, methyl instead of H in pat' 873 to come up to the claimed compounds since adjacent homologs are suggested for the same uses. One having ordinary skilled in the art would have been motivated to use an adjacent homolog of a known compound for the same uses with a reasonable expectation of success.

6. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO98/02420 , WO97/34870 and patent 5,484,944. Note the 102b rejection above. Isomers or homologs of the known compounds are suggested.

7. Claims 1-11 are objected as being drawn to Improper Markush groups. Deletion of the non-elected subject matter would ovecome this rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane T. Fan whose telephone number is 703-308-4705. The examiner can normally be reached on 7:00am-3:30pm, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4734 for regular communications and 703-308-4734 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Jane T. Fan  
Primary Examiner  
Art Unit 1625

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July 3, 2003



JANE FAN  
PRIMARY EXAMINER  
GROUP 1200